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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,835	02/27/2004	Todd A. Thompson	960296.00516	8254

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EXAMINER
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ANDERSON, JAMES D

ART UNIT	PAPER NUMBER
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1614

NOTIFICATION DATE	DELIVERY MODE
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01/14/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

pat-dept@quarles.com

<p align="center"><b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b></p>	<p><b>Application No.</b> 10/789,835</p>	<p><b>Applicant(s)</b> THOMPSON ET AL.</p>	
	<p><b>Examiner</b> JAMES D. ANDERSON</p>	<p><b>Art Unit</b> 1614</p>	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 02 December 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 16 December 2008. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: \_\_\_\_\_.
- Claim(s) objected to: \_\_\_\_\_.
- Claim(s) rejected: 1, 2, 5, 6, 8, and 9.
- Claim(s) withdrawn from consideration: 11-24.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☒ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_
13. ☐ Other: \_\_\_\_\_.

/Ardin Marschel/  
Supervisory Patent Examiner, Art Unit 1614

/James D Anderson/  
Examiner, Art Unit 1614

Continuation of 3. NOTE: The amendments to claims 1, 2, 5-6, and 8-9 will not be entered because they raise new issues that would require further consideration and/or search. Specifically, with respect to claims 8 and 9, the proposed amendment raises a question as to how one can prevent recurrence of prostate cancer in a patient who "presently has" androgen-dependent prostate cancer.

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments have been carefully considered but they are not deemed persuasive. The rejections set forth in the Final Office Action mailed 6/20/2008 are maintained for the reasons of record. With regard to the 35 U.S.C. 112, 2nd Paragraph rejection of claims 1-2, 5-6, and 8-9, Applicants arguments require that the proposed amendments be entered. However, as discussed in 3) above, the proposed amendments will not be entered because they raise a new issue in claims 8-9. Accordingly, this rejection is maintained for the reasons of record. With regard to the 35 U.S.C. 112, 1<sup>st</sup> paragraph rejection of claims 1-2, 5-6, and 8-9, Applicants arguments require that the proposed amendments be entered. However, as discussed in 3) above, the proposed amendments will not be entered because they raise a new issue in claims 8-9. Accordingly, this rejection is maintained for the reasons of record. With regard to the 35 U.S.C. 103 rejection of claims 1-2 and 5-6, the Examiner is not persuaded by Applicant's arguments that it would not have been obvious to have administered PMC to patients with androgen-dependent prostate cancer. Applicants argue that PMC and a-tocopherol have "very different properties" based on structural differences that are relevant to the invention. In response, the Examiner refers to the cited prior art references which teach that 1) antioxidants (including a-tocopherol) modulate human prostate cancer cell proliferation by altering apoptosis in dividing cells and 2) that PMC (which is structurally related to a-tocopherol) is a more potent antioxidant than a-tocopherol. As such, one skilled in the art would have been motivated to try PMC for inhibiting the growth of androgen-dependent prostate cancer cells with a reasonable expectation of success. In fact, Applicants appear to acknowledge that the chromanol group (which is present in both a-tocopherol and PMC) is responsible for the antioxidant activity of the a-tocopherol molecule. Further, the Examiner is not persuaded by Applicant's argument that because the phytyl tail of a-tocopherol is missing from PMC, PMC would not be expected to penetrate into prostate cancer cell because there are numerous compounds that inhibit prostate cancer cell proliferation that do not contain a phytyl tail. As such, a phytyl tail is clearly not a requirement for a compound to be able to enter a cell. With regard to Applicant's discussion of antioxidants and cancer, while it is certainly true that there are antioxidants that do not function as anticancer agents, this is not pertinent to the present rejection. Other antioxidants are not under examination. Even if the anti-prostate cancer activity of a-tocopherol is not due directly to its antioxidant activity, the skilled artisan would reasonably expect that a compound with an identical core structure, missing only the phytyl tail of a-tocopherol, would exhibit similar activity to a-tocopherol.

/Ardin Marschel/  
Supervisory Patent Examiner, Art Unit 1614